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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PICH, PONNOREAY	
ART UNIT	PAPER NUMBER
2435	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/787,722	CHEVREAU ET AL.	
	Examiner	Art Unit	
	PONNOREAY PICH	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9* is/are allowed.

6)☒ Claim(s) *1,3-5,8,10 and 11* is/are rejected.

7)☒ Claim(s) *2,6 and 12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-12 are pending.

Response to Arguments

Applicant's remarks were fully considered. It is noted that applicant pointed out some typos that were present in the prior office action. Applicant's attention to detail is appreciated and the examiner has made appropriate corrections to the typos pointed out by applicant.

As per claim 1, applicant argues that Linnartz does not teach "identifying whether said digital data are encrypted" or "delivering one of a permission and a prohibition to copy and/or to play said digital data as a function of an identification of: - an encryption of said digital data; **and** - a watermarking of said digital data". The examiner respectfully disagrees. It is noted that both the examiner and applicant appear to agree as to what the cited sections of Linnartz discloses. Where we appear to disagree is whether what Linnartz discloses in the cited portions meets the limitation as claimed—that is can one interpret claim 1 in such a way that Linnartz's teachings meet the limitations as claimed.

As per the limitation of "identifying whether said digital data are encrypted", the examiner respectfully submits that a digital signature as understood by one skilled in the art refers to an output obtained by a one way encryption of digital data. Cited column 7, lines 64-67 states that a recorder accepts contents (i.e. for recording) if the content and a cleartext version of the watermark bits are signed. Detection of the content being signed reads on identifying whether the content/digital data are encrypted. Further,

note that Linnartz further discloses that a signal/content may be additionally protected by encryption methods or may be provided with a digital signature (col 10, lines 4-7). If a content/digital data used with Linnartz's invention may be protected via encryption, this implies that one would have to determine whether the digital data is encrypted or not so as to determine whether one should decrypt it or not so as to ensure proper playback of the content. This also reads on the limitation of "identifying whether said digital data are encrypted".

As per the limitation of "delivering one of a permission and a prohibition to copy and/or to play said digital data as a function of an identification of: - an encryption of said digital data; **and** - a watermarking of said digital data", as discussed above, recorders in Linnartz's invention may accept content without detecting the watermark if the content has an accompanying signature (col 7, lines 64-67). This section also implies that if there is no signature detected, then if there is a watermark present, then the recorder may also accept the content, depending on the watermark. As such, permission of whether or not the recorder may accept the content for copying is dependent on or is a function of an encryption of the digital data and a watermarking of the digital data. Column 6, lines 1-15 also discloses that a playback device is allowed to playback content if certain conditions related to the watermark is met--this implies that playback permission is delivered as a function of a watermarking of the digital data and taken in light of the recording permission being delivered as a function of an encryption of digital data as already discussed, the limitation of "delivering one of a permission and a prohibition to copy and/or to play said digital data as a function of an identification of: -

an encryption of said digital data; **and** - a watermarking of said digital data" is met by Linnartz.

With respect to claim 3, applicant argues that Linnartz does not teach delivering one of a permission and prohibition to copy and/or to play said digital data as a function of an identification of: an encryption of said digital data; and a watermarking of said digital data because if a content is in state d, watermarking and encryption of digital data is not identified by Linnartz since the content is in a free copy state. The examiner respectfully disagrees. Consider the following equation:

Y = 3x, if x>5; or

3x+z, if x<5.

In the above example equation, regardless of Y being only dependent on x if certain conditions are true for x, one would still say that Y a function of x and z. Similarly, in Linnartz's invention, while it is true that in a copy free state d, the encryption of the data and the watermarking of the data is not identified for copying permission to be delivered, this does not change the fact that copy permission is still delivered in other states depending on identification of the encryption and watermarking of the digital data. As such, one or a permission and/or prohibition to copy and/or play said digital data is still a function of an identification of: an encryption of said digital data; and a watermarking of said digital data.

With respect to claim 4, applicant argues that Linnartz does not teach delivering a prohibition of playing of said digital data when: an encryption of said digital data has not been identified; and a watermarking of said digital data has been identified. Note

that col 10, lines 4-7 of Linnartz states that encryption may additional be used to secure digital data in his invention. This implies that the digital data may or may not be encrypted. Thus, given that there may be digital data that is not encrypted, it would be impossible for encryption of the digital data to be identified. However, in column 5, lines 30-47, regardless of whether the data is encrypted or not and encryption is identified or not, permission or prohibition of playing the digital data is delivered when watermarking of the digital data is identified, which indicates the state of the digital data. As such, the limitation further recited in claim 4 is met.

The remaining arguments are towards allowance of the claims due to dependency on claim 1. However, since the arguments for claim 1 were traversed, the dependent claims that are not indicated as allowable in the office action are also not allowable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, 8, and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Linnartz (US 6,314,518).

Claim 1:

Linnartz discloses:

1. Identifying whether said digital data are encrypted (col 7, lines 64-67). *Signing the digital content means that a one way cryptographic algorithm was applied to the content. Identifying whether or not a signature of the content exists means identifying whether the digital content was encrypted, i.e. processed using the one way cryptographic hash algorithm.*
2. Identifying whether said digital data are watermarked (col 2, lines 10-19 and col 5, lines 4-10). *Note that before allowing the content to be played, the content is checked for a watermark, which would define what state the content is in.*
3. Delivering one of a permission and a prohibition to copy and/or to play said digital data as a function of an identification of:
    a. An encryption of said digital data (col 7, lines 64-67); and
    b. A watermarking of said digital data (col 5, lines 1-10 and 42-52 and col 7, lines 64-67).

Claim 3:

Linnartz further discloses delivering a permission for digital copying when: an encryption of said digital data has not been identified; and a watermarking of said digital data has not been identified (col 5, lines 1-10). The cited portion discloses that content, if it lacks a watermark is considered to be in state d, a free copy state. There being no

watermark means that the watermark has not been identified and the data being in a free copy state means a copy permission is delivered whether or not encryption of digital data is identified.

Claim 4:

Linnartz further discloses delivering a prohibition of playing of said digital data when: an encryption of said digital data has not been identified; and a watermarking of said digital data has been identified (col 5, lines 30-47).

Claim 5:

Linnartz further discloses:

1. Identifying the type of storage medium (col 4, lines 1-45).
2. Delivering a prohibition of copying when:
    a. An encryption of digital data has been identified (col 7, lines 64-67). *Only if the content was signed by a compliant and authorized device would the recorder be allowed to copy content. This means that if the signature is identified as being signed by a non-compliant or unauthorized device, the recorder would be prohibited from copying.*
    b. A watermarking of said digital data has been identified (col 5, lines 1-10 and 42-52 and col 7, lines 64-67).
    c. A recordable type of storage medium has been identified (col 4, lines 1-18 and col 5, lines 35-44).

Claim 8:

Linnartz further discloses wherein the prohibition of digital copying comprises a blocking of output of the digital data (col 4, lines 1-3).

Clam 10:

Linnartz further discloses identifying the type of storage medium; and delivering one of a permission and a prohibition to copy and/or to play said digital data as a further function of the identification of a recordable or non-recordable type of storage medium (col 4, lines 1-45).

Claim 11:

Linnartz further discloses identifying whether a cryptographic signature accompanies said digital data (col 8, line 63-col 9, line 41); and delivering one of a permission and a prohibition to copy and/or to play said digital data as a further function of the identification of a cryptographic signature accompanying said digital data (col 8, line 63-col 9, line 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (US 6,314,518) in view of Ichinoi (US 6,266,477).

Claim 7:

Linnartz does not explicitly disclose the following limitations, but they are disclosed by Ichinoi:

1. Converting the digital data into analog signals (col 3, lines 4-7 and col 4, lines 19-30).
2. Corrupting the analog signals if a prohibition of digital copying is delivered (col 11, lines 21-35).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Linnartz's invention according to the limitations recited in claim 7 in light of Ichinoi's teachings. One skilled would have been motivated to incorporate Ichinoi's teachings in which digital data is converted to analog signals because Ichinoi recognizes that there are still technology that consumers have which are analog in nature, thus there exists a need in the art for digital systems to be backwards compatible with these analog systems (col 1, lines 23-33 and col 2, lines 13-18). One of ordinary skill would have been motivated to incorporate Ichinoi's teachings of corrupting the analog signals if a prohibition of digital copying is delivered because it would help prevent copying of protected material (col 11, lines 33-35).

Allowable Subject Matter

Claim 9 is allowed.

Claims 2 and 6 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Claim 12 would also be allowed due to dependency on claim 6 if claim 6 were rewritten to include all the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PONNOREAY PICH whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/
Examiner, Art Unit 2435

/KimYen Vu/

Supervisory Patent Examiner, Art Unit 2435